

REMARKS

This is a full and timely response to the final Official Action mailed February 4, 2010 (the “Office Action” or “Action”). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Request for Continued Examination (RCE):

Applicant hereby requests Continued Examination for this application and entry and consideration of this amendment consequent thereto.

Claim Status:

Under the imposition of a previous provisional restriction requirement, claims 33-42 have been withdrawn from consideration. Applicant will be entitled to rejoinder of those claims upon allowance of independent claims 1, 20 and 28. MPEP § 821.04.

By the forgoing amendment, claims 1, 2, 3, 4, 28, 31 and 33 have been amended. Further, original claims 30 and 34 have been cancelled without prejudice or disclaimer. Claim 21 has also been cancelled previously without prejudice or disclaimer. Thus, claims 1-20, 22-29, 31 and 32 are currently pending for further action.

Prior Art:Rejections under 35 U.S.C. §102(a) or § 102(e):

- (1) In the recent Office Action, claims 1 and 5 were rejected under 35 U.S.C. § 102(a) or §102(e) as being anticipated by U.S. Patent No. 6,945,650 to Beverly (“Beverly”). For at least the following reasons, this rejection should be reconsidered and withdrawn.

Claim 1

Claim 1 recites:

An ophthalmic apparatus comprising:  
an eye-positioning device comprising:  
*a feedback device configured to provide information to a subject who is moving an eye from a current position to a desired position relative to the eye positioning device;* and  
an applicator for dispensing the fluid into the eye conditionally upon positioning of the eye in the desired position.

(Emphasis added)

Support for the amendment to claim 1 can be found in Applicant's originally filed specification at, for example, paragraphs [0035-0036] as well as originally filed claim 20.

In contrast, Beverly does not teach or suggest “[a]n ophthalmic apparatus comprising a feedback device configured to provide information to a subject who is moving an eye from a current position to a desired position relative to the eye positioning device.” (Claim 1).

It should be first noted that the Action concedes that “Beverly does not expressly teach that the feedback device provides information to the subject that assists the subject in moving the eye from the current position to a predetermined position relative to the dispensing apparatus.” (Action, p. 5). Additionally, nowhere in Beverly is it taught or suggested that a subject receives instructions from a feedback device to change his or her eye position relative to the apparatus. In fact, Beverly teaches that the “[h]eads-up display 24 comprises a polar array 82 of light-emitting diodes 84 . . . *for providing an X-Y alignment instruction to the operator.*” (Beverly, col. 7, ll. 54-67) (emphasis added). Additionally, Beverly teaches that “*the operator* is being instructed *to move the instrument* lower and to the left for X-Y alignment, and closer to the eye for Z alignment.” (*Id.* at col. 8, ll. 28-53). Clearly, Beverly teaches that another person, namely the operator, is instructed to move the instrument.

In contrast, however, claim 1 recites that “a feedback device [is] configured to provide information to the *subject* in *moving the eye* from the current position to a desired position relative to the eye positioning device.” (Claim 1) (emphasis added). Beverly fails to teach all of the limitations found in claim 1.

Respectfully, to anticipate a claim, a reference must teach each and every element of the claim, and “the identical invention must be shown in as complete detail as contained in the ... claim.” MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989) (emphasis added). Moreover, “[t]he prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’” *NetMoneyIn v. Verisign*, (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983)).

In the present case, Beverly clearly does not disclose the claimed invention with each and every claimed element in the same amount of detail or as arranged in the claim. Consequently, because Beverly clearly fails to satisfy the requirements for anticipating claim 1, the rejection of claim 1 and its dependent claims should be reconsidered and withdrawn.

Rejections under 35 U.S.C. § 103(a):

- (1) In the recent Office Action, claims 2, 4, 6, 8, 20, and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,945,650 to Beverly (“Beverly”) For at least the following reasons, this rejection should be reconsidered and withdrawn.

Claim 20

Claim 20 recites:

An ophthalmic apparatus, comprising:  
a dispensing apparatus for dispensing fluid into an eye of a subject;  
an eye-position detector for detecting the current position of the eye  
relative to the dispensing apparatus; and  
a feedback device for receiving information from the eye-position  
detector corresponding to the position of the eye, and for providing feedback  
information that **assists the subject in moving the eye** from the current  
position to a predetermined position relative to the dispensing apparatus for  
administering the fluid to the eye.

(Emphasis added)

In contrast, Beverly does not teach or suggest “[a]n ophthalmic apparatus, comprising . . . a feedback device for receiving information from the eye-position detector corresponding to the position of the eye, and for providing feedback information that assists the subject in moving the eye from the current position to a predetermined position relative to the dispensing apparatus for administering the fluid to the eye.” (Claim 20).

Again, the Action has conceded that “Beverly does not expressly teach that the feedback device provides information to the subject that assists the subject in moving the eye from the current position to a predetermined position relative to the dispensing apparatus.” (Action, p. 5). In an attempt to overcome this deficiency, the Action argues that because it may have been obvious to “pursue known options (providing feedback to the subject to move his/her eyes for alignment), that that obviousness to try may equate to obviousness. (*Id.*) The Applicant respectfully disagrees: such an alteration of Beverly would render it inoperable for its intended purpose.

Beverly teaches that a heads-up display is provided to the operator and comprises “LEDs 84 in polar array 82 . . . whereby the LEDs are selectively illuminated depending upon the X-Y alignment status of the instrument relative to the eye.” (*Id.* at col. 7, ll. 53-67).

Additionally, Beverly teaches that “an LED 84 is illuminated corresponding to an appropriate directional pointer instructing the operator of the direction to move the instrument to align optical axis 14 with corneal vertex V.” (Id. at col. 8, ll. 1-27). Therefore, it is obvious that if the subject in Beverly were to align his or her own eye using the heads up display as suggested in Beverly, the subject would be forever checking to see if the adjustments to the eye were correct per the heads-up display and subsequently attempting to place that same eye (which is being aligned) in the correct position, just to have to look to see on the heads-up display yet again if the position is correct. Simply put, the apparatus in Beverly cannot be used by a single person. In fact, Beverly repeatedly teaches that an “operator” is to check the heads-up display and adjust the apparatus: not the subject. (See, for example, Beverly, col. 7, ll. 54-67 and col. 8, ll. 28-53). Therefore, Beverly fails to teach or suggest the recitations found in claim 20.

The Supreme Court recently addressed the issue of obviousness in *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007). The Court stated that the *Graham v. John Deere Co. of Kansas City*, 383, U.S. 1 (1966), factors still control an obviousness inquiry. Under the analysis required by *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Beverly, did not include the claimed subject matter, particularly an ophthalmic apparatus, comprising a feedback device for receiving information from the eye-position detector corresponding to the position of the eye, and for providing feedback information that assists the subject in moving the eye from the current position to a

predetermined position relative to the dispensing apparatus for administering the fluid to the eye.

The differences between the cited prior art and the indicated claims are significant because recitation of claim 20 provides for an ophthalmic apparatus which may provide feedback to a subject without the need for any intervention from any other person. Thus, the claimed subject matter provides features and advantages not known or available in the cited prior art. Consequently, the cited prior art will not support a rejection of claim 1 under 35 U.S.C. § 103 and Graham. Therefore, for at least the reasons explained here, the rejection based on Beverly of claim 1 and its dependent claims should be reconsidered and withdrawn.

(2) In the recent Office Action, claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over 6,945,650 to Beverly (“Beverly”) in view of U.S. Patent No. 6,270,467 to Yee (“Yee”). The rejection of claim s should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of independent claim 1.

(3) In the recent Office Action, claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over 6,945,650 to Beverly (“Beverly”) in view of U.S. Patent No. 6,299,305 to Miwa (“Miwa”). The rejection of claim 7 should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of independent claim 1.

(4) In the recent Office Action, claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over 6,945,650 to Beverly (“Beverly”) in view of U.S. Patent No. 5,171,306 to Vo (“Vo”). For at least the following reasons, this rejection should be reconsidered and withdrawn.

Claim 28

Claim 28 recites:

An ophthalmic apparatus for administering a liquid to an eye of a subject, comprising:

detecting means for detecting the position of the eye;

*feedback means for receiving information from the detecting means corresponding to the position of the eye, and for providing feedback information that assists the subject in moving the eye from the current position to a predetermined position relative to the ophthalmic apparatus;*

and

dispensing means for dispensing the liquid into the eye only when the eye is in the predetermined position.

(Emphasis added)

Support for the amendment to claim 28 can be found in Applicant's originally filed specification at, for example, paragraphs [0035-0036] as well as originally filed claim 20.

In contrast, Beverly or Vo or any combination thereof teach or suggest “[a]n ophthalmic apparatus . . . comprising: . . . feedback means for receiving information from the detecting means corresponding to the position of the eye, and for providing feedback information that assists the subject in moving the eye from the current position to a predetermined position relative to the ophthalmic apparatus.” (Claim 28).

As discussed earlier in relation to claim 1 and 20, it should first be noted that the Action concedes that “Beverly does not expressly teach that the feedback device provides information to the subject that assists the subject in moving the eye from the current position to a predetermined position relative to the dispensing apparatus.” (Action, p. 5).

Additionally, nowhere in Beverly is it taught or suggested that a subject receives instructions from a feedback device to change his or her eye position relative to the apparatus. In fact, Beverly teaches that the “[h]eads-up display 24 comprises a polar array 82 of light-emitting diodes 84 . . . *for providing an X-Y alignment instruction to the operator.* (Beverly, col. 7,

ll. 54-67) (emphasis added). Additionally, Beverly teaches that “***the operator*** is being instructed ***to move the instrument*** lower and to the left for X-Y alignment, and closer to the eye for Z alignment.” (*Id.* at col. 8, ll. 28-53). Clearly, Beverly teaches that another person, namely the operator, is instructed to move the instrument.

Additionally, nowhere in Vo is a feedback means taught, nor is it taught that feedback information is provided that assists the subject in moving the eye from the current position to a predetermined position relative to the ophthalmic apparatus.

In contrast, however claim 28 recites “[a]n ophthalmic apparatus . . . comprising: . . . feedback means for receiving information from the detecting means corresponding to the position of the eye, and for providing feedback information that assists the subject in moving the eye from the current position to a predetermined position relative to the ophthalmic apparatus.” (Claim 28). Neither Beverly nor Vo or any combinations thereof teach the recitations found in claim 28.

Again, under the analysis required by *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Beverly and Vo, did not include the claimed subject matter, particularly an ophthalmic apparatus comprising feedback means for receiving information from the detecting means corresponding to the position of the eye, and for providing feedback information that assists the subject in moving the eye from the current position to a predetermined position relative to the ophthalmic apparatus.

The differences between the cited prior art and the indicated claims are significant because recitation of claim 28 provides for an ophthalmic apparatus which may provide

feedback to a subject without the need for any intervention from any other person. Thus, the claimed subject matter provides features and advantages not known or available in the cited prior art. Consequently, the cited prior art will not support a rejection of claim 28 under 35 U.S.C. § 103 and Graham. Therefore, for at least the reasons explained here, the rejection based on Beverly and Vo of claim 28 and its dependent claims should be reconsidered and withdrawn.

(5) In the recent Office Action, claims 11-13, 17, and 32 rejected under 35 U.S.C. § 103(a) as being unpatentable over 6,945,650 to Beverly (“Beverly”) in view of U.S. Patent No. 5,171,306 to Vo (“Vo”) in further view of U.S. Patent No. 5,368, 582 to Bertera (“Bertera”). The rejection of claims 11-13, 17, and 32 should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of independent claims 1 and 28 respectively.

(6) In the recent Office Action, claims 24-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over 6,945,650 to Beverly (“Beverly”) in view of U.S. Patent No. 6,159,186 to Wickham et al. (“Wickham”) in further view of U.S. Patent No. 5,171,306 to Vo (“Vo”). The rejection of claims 24-27 should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of independent claim 20.

Conclusion:

In view of the foregoing arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further

arguments in future papers supporting the patentability of any of the claims, including the separate patentability of the dependent claims not explicitly addressed herein. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

The absence of a reply to a specific rejection, issue or comment in the Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

If the Examiner has any comments or suggestions which could place this application in better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

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